

REMARKS

This Response under 37 C.F.R. §1.143 is in response to an election/restriction requirement (Paper No. 20060515) mailed 18 May 2006.

In Paper No. 20060515 mailed on 18 May 2006, the Examiner imposed a restriction between:

- **Group I** covered by claims 7-9, drawn to a method of making a packing crate, classified in class 493, subclass 84; and
- **Group II** covered by claims 22-37, drawn to a container, classified in class 229, subclass 198.

Applicant provisionally elects Group II covered by claims 22-37, drawn to a container, classified in class 229, subclass 198, with traverse.

It is kindly noted that this restriction requirement between method and apparatus claims is similar to the one previously imposed by the same Examiner on May 31, 2005 (Paper No. 20050524), petitioned by the Applicant in a 37 C.F.R. 1.144 petition filed November 1, 2005 and granted by Director Frederick Schmidt on February 17, 2006. Applicant therefore submits that the imposition of the present restriction requirement of Paper No. 20060515 violates the notions of compact prosecution and fairness as this issue has already been decided. Further, Applicant would like to point out that Applicant is a small entity with limited resources and that such practice on the part of the Examiner is unfairly prejudicing Applicant's rights.

Applicant traverses the present restriction requirement for the following reasons:

1. There is no serious burden imposed on the Examiner by having to examine all pending claims on the merits in a single examination

Applicant submits that there is no serious burden on the Examiner if the Examiner were to examine method and apparatus claims together. This is because this was previously done by the Examiner in the November 17, 2004 Office action (Paper No. 20041112). In Paper No. 20041112, the Examiner presumably already searched both 493/84 and 229/198 and never indicated on the record that doing so was a serious burden. Because there is no serious burden on the part of the Examiner, the restriction requirement of Paper No. 20060515 is without merit.

2. A single embodiment must never be restricted

MPEP 806.03 mandates that a patent application must never be restricted when only a single embodiment is disclosed and claimed. In the present application, only one embodiment is disclosed and claimed. Therefore, Applicant submits that the restriction requirement of Paper No. 20060515 violates MPEP 806.03 and therefore must be withdrawn.

3. Examiner's justification for the restriction requirement is entirely without merit

In Paper No. 20060515, the Examiner justified the restriction requirement by saying that "the

method claim require a folding over the strip at an edge of the stack of paper while the article claims does not require this step this making inventions I and II distinct. Furthermore, the container as claimed can be made by other method like immersing the threads with adhesive prior⁴ to sewing.” Applicant disagrees.

Applicant submits that immersing the thread prior to sewing would not be a practical solution. To begin with, the Examiner has not presented any evidence that such a method would achieve the same ends as Applicant’s invention. Further, Applicant submits that an insufficient amount of adhesive or wax would be present in such a method and that such a method would therefore not be able to plug up or seal off the holes created by the sewing process as in Applicant’s invention. Further, the adhesive on the thread would make it impossible for a sewing machine to handle the thread. Further, the adhesive will come off the thread during the sewing process thus preventing a proper seal.

Regarding the Examiner’s assertion that the method claims claim folding over a strip and the apparatus claims do not require this, Applicant submits that following. An apparatus claim ordinarily claims a structure, not a process. Thus, one would not expect an apparatus claim to have such a method limitation. Nevertheless, Applicant has product by process claims 29 and 36 pending, and Applicant’s claim 29 claim the folding over of the strip step. Further, Applicant’s apparatus claim 28 also claims this folding of the strip. Applicant further submits that the Examiner has not presented any evidence as to how the strip can be formed other than a folding method. Because of